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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Docket No.: P26741

F. KNAUSEDER

Confirmation No.: 2541

Serial No.: 09/814,066

Group Art Unit: No. 3673

Filed: June 21, 2001

Examiner: M. Safavi

For: **FLOORING PANELS**

REPLY BRIEF UNDER 37 C.F.R. 41.41(a)(1)

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop **Appeal Brief - Patents**
Randolph Building
401 Dulany Street
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Sir:

This Reply Brief is in response to the Examiner's Answer dated November 21, 2006, the period for reply extending until January 22, 2007 (January 21, 2007 being a Sunday).

The Examiner maintains the grounds of rejection advanced in the final rejection of claims 1-3, 21-25 and 31-36 and provides arguments in support thereof.

Appellant notes this Reply Brief is being filed under 37 C.F.R. 41.41(a)(1) and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief. With regard to this Reply Brief, Appellant notes it is addressing points made in the Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

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POINTS OF ARGUMENT

First Issue

On the Pages 10-12, section 10 (*Response to Arguments*), the Examiner asserts that the term “pre-applied adhesive” used in the “claims is limited to that which is disclosed by U.S. Patent 4,417,028 to Azevedo.” This is a mischaracterization of Appellant’s argument.

Appellant has instead argued that the term “pre-applied adhesive” has a specific meaning in the art and has cited Azevedo as evidence that the term has the meaning which Appellant believes the Examiner is ignoring.

Indeed, in the Supplemental Appeal Brief, Appellant stated the following:

Appellant refers the Board to U.S. Patent No. 4,417,028 to AZEVDO (a copy of which was attached to the Rule 1.116 Response) which contains an accurate description of such substances. Such substances are typically stable compositions which are prepared and pre-applied to “surfaces prior to the time of assembly, which will remain on the parts during normal storage and shipment, and which will cure upon mating with another part thereby imparting an effective and improved seal or bond.” See col. 1, lines 56-68 of AZEVDO. Such substance also typically ensure that the pre-applied parts “can then be shipped or stored for substantial periods of time prior to cure” and are “dry to the touch. Finally, such substances may also have the attribute that “when crushed or ground by a mating surface, cures to a strong bond” (see col. 2, lines 1-22 of AZEVDO). Indeed, these properties, as well as other properties, are specifically acknowledged and noted on pages 5-14 of the instant specification in discussing examples of the types of substances which can be utilized in the invention.

As is clear from the noted language, the term “pre-applied adhesive”, as recited in the claims, has a specific meaning in the art and the Examiner is simply not free to ignore this meaning in favor of one which suits the Examiner.

Second Issue

On the Page 10, section 10 (*Response to Arguments*), the Examiner also asserts that DE '962 teaches to use a contact adhesive at the factory and that this contact adhesive is the same as the recited pre-applied adhesive. Appellant respectfully disagrees.

Appellant acknowledges that DE '962 discloses a contact glue which requires that the mating surfaces "be pressed together with a considerable degree of pressure, making it impossible to additionally adjust the glued joint in the longitudinal direction for the purpose of closing a transverse joint." However, the Examiner has failed to appreciate that the factory application of an adhesive is not a *per se* disclosure of a pre-applied adhesive or pre-applied substance because, as was explained above, a pre-applied adhesive or substance is a type of adhesive or substance which allows the components having the same applied off-site to be connected at a later point in time and which is activated by the very connecting of the joint.

Third Issue

On the Page 10, section 10 (*Response to Arguments*), the Examiner additionally asserts that DE '962 teaches to use a contact adhesive at the factory and that this contact adhesive reads on the recited pre-applied adhesive. Appellant respectfully disagrees.

Independent claim 1, for example, recites a configuration for combining flat structural components which utilizes the combination of a tongue and groove

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connection wherein both the tongue and groove have divergent sides and integrated locking mechanisms and which also includes a pre-applied adhesive layer or a pre-applied layer of a substance which activates adhesive is applied off-site and is present on the groove at least in the area of its divergent sides or on the tongue at least in the area of its divergent wedge-shaped area, or on both areas.

As is apparent from the claim language, the claims require the off-site application of the pre-applied adhesive followed by a connection of the joint. DE '962, on the other hand, appears to teach the factory application of a contact glue to one of the members of a joint in order to connect members at the factory.

Thus, even if the Examiner were correct (which Appellant disputes) that a contact adhesive reads on the recited pre-applied adhesive, the Examiner has failed to explain how the factory application of a contact adhesive to secure a joint at the factory discloses or suggests the application of a pre-applied adhesive to joint members at the factory so that the flat components can be connected at some future point in time as recited in the claims.

Fourth Issue

On the Page 12, section 10 (*Response to Arguments*), the Examiner asserts that the term “pre-applied” does not limit the recited adhesive or adhesive substance because this term relates to “when” it is applied rather than “what” is applied. Appellant respectfully disagrees.

As explained above in the First Issue, a pre-applied adhesive or substance is a type of adhesive or substance which allows the components having the same applied off-site to be connected at a later point in time and which is activated by the very connecting of the joint. Thus, the term relates to what is applied instead of when it is applied.

Again, as is clear from the above-noted quoted language of AZEVEDO, the term “pre-applied adhesive”, as recited in the claims, has a specific meaning in the art and the Examiner is simply not free to ignore this meaning in favor of one which suits the Examiner.

Fifth Issue

In section 10 (*Response to Arguments*), the Examiner neglects to set forth any response to Appellant’s assertion that there is no proper basis for combining the teachings of the applied documents. In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason *why* one of ordinary skill in the art would have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972 (B.P.A.I. 1985) To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Applicant’s disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). As noted above and in the Supplemental Appeal Brief, each of the applied documents is

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silent with regard to a number of recited features and each of the documents relates to different devices that function in different manners. Moreover, none of the documents teaches or suggests modifying the structure or operation of AT 405 560 in the manner asserted by the Examiner.

Because the art of record fails to provide any reasonable explanation why one ordinarily skilled in the art would utilize such an arrangement, and/or fails to disclose or suggest the problems that such an arrangement would address, Appellant submits that the art of record fails to provide the requisite motivation or rationale as to *why* one ordinarily skilled in the art would modify AT 405 560 to include features of any of the secondary references in the manner asserted by the Examiner. That is, Appellant submit that because the Examiner has not set forth any basis or reason found in the art of record for combining these documents, the instant rejection has no basis in the art of record, such that the rejection is improper and should be withdrawn.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner has the initial duty of supplying the factual basis for the rejection and may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). As stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), *cert.* {P26741 00118889.DOC}

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denied, 469 U.S. 851 (1984):

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.


Appellant submits that the only reason to combine the teachings of the applied references in the manner proposed by the Examiner is the result of a review of Appellant's disclosure and the application of impermissible hindsight.

CONCLUSION

Accordingly, in view of the above-noted arguments (as well as those already of record), the Board is respectfully requested to reverse the Examiner's decision to finally reject claims 1-3 and 8-44 under 35 U.S.C. §§ 102(b) and 103(a), and that the application be remanded to the Examiner for withdrawal of the rejection over the applied documents and an early allowance of all claims on appeal.

Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 19-0089.

Respectfully submitted,
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January 19, 2007
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